

Page 7 of 13
Application. No. 09/488,337
Amendment E

REMARKS

Responsive to the Office Action mailed October 21, 2004, Applicants provide the following. The claims have not been amended, therefore twenty-four (24) claims remain pending in the application: claims 1-24. Reconsideration of claims 1-24 in view of the remarks below is respectfully requested.

Initially, Applicants acknowledge with appreciation the Examiner's willingness to take part in the telephonic interview on March 3, 2005. A summary of the interview is provided below.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Summary of Applicant Initiated Examiner Interview

1. Per 37 CFR § 133(b), the following is a brief summary of the Examiner interview conducted on March 3, 2005 via telephone between Thomas F. Lebens and Steven M. Freeland, Attorneys of Record, and Examiner Joseph E. Avellino. The Applicants' previously submitted Declaration under 37 C.F.R. § 1.131 swearing behind U.S. Patent No. 6,535,909 (Rust) was discussed. Applicants demonstrated that the current rejection (i.e., obviousness rejection under 35 U.S.C. 103) could in fact be over come by a Declaration swearing behind the Rust patent.

Applicants further pointed out that the refusal to accept the 1.131 Declaration based on the fact that the subject application was claiming the same subject matter claimed in the Rust patent was an impermissible conclusion based on the Examiner's 35 U.S.C. § 103(a) rejection. Further, Applicants demonstrated that if in fact the pending claims are directed to the same patentable invention as the Rust patent (which Applicants do not believe the pending claims are directed to the same invention), then the rejection should not have been a § 103 rejection, but instead a rejection under 35 U.S.C. § 135 which refers to an application claiming

408941_1

Page 8 of 13
Application No. 09/488,337
Amendment E

the same invention as a previous patent, and thus, the Examiner would need to issue a new rejection based on §135 grounds. The Examiner was unable to fully address Applicants arguments because he did not anticipate Applicants' objection, and needed further time to evaluate 35 U.S.C. 135. Therefore, the Examiner requested that Applicants submit the arguments in writing.

The Examiner also requested that a new Declaration under 37 C.F.R. §1.131 be submitted that is executed by each of the named inventors. Applicants submit herewith a new Declaration for execution by each of the named inventors. As of the date of filing this response, only two (2) of the three inventors have signed the attached Declaration. Applicants will follow shortly the filing of this response with the Declaration that is has been executed by each of the three named inventors.

Claim Rejections - 35 U.S.C. 103

2. Claims 1-24 stand rejected under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 6,161,132 (Roberts et al.) in view of U.S. Patent No. 6,535,909 (Rust). Applicants traverse this rejection and submit a declaration under 37 C.F.R. §1.131 demonstrating that Applicants conceived and reduced to practice the invention as claimed prior to the effective date of the Rust patent.

Applicants note that Rust was not published more than one year before the filing date of the present application, thus, the Rust patent can not be used as a proper reference under 35 U.S.C. 102(b)/103(a).

In order to remove the Rust patent cited for the rejection of claims 1-24 under 35 U.S.C. 103 Applicants submit evidence establishing a reduction to practice of the claimed invention prior to the filing date of the Rust patent, i.e., prior to November 18, 1999; thus, overcoming a rejection under 35 U.S.C. 103(a) by establishing the invention of Applicants' claimed invention prior to the filing date of the Rust patent. This evidence is submitted in the form of the following declaration under 37 C.F.R. 1.131: (a) the Declaration of Evgeniy M. Getsin; Michael J. Lewis; and Todd R. Collart (hereinafter referred to as "the 131 declaration").

408941_1

Page 9 of 13
Application No. 09/488,337
Amendment E

Per MPEP 715.07, the dates have been blocked out of the exhibits attached to the 131 declaration; however, all dates are prior to November 18, 1999.¹

When any claim of an application is rejected, the inventor of the subject matter of the rejected claim may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the filing date of the reference on which the rejection is based.²

A declaration submitted under 37 C.F.R. §1.131 is a proper response to a 35 U.S.C. 103(a). MPEP 715.03 specifically stated, "Applicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references." (Emphasis added). Therefore, Applicants submit that the attached 131 declaration is proper in overcoming a 103(a) rejection.

The Examiner states in the October 21, 2004 office action on page 5 that a "declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention." Applicants respectfully submit, however, that the pending claims do not claim the same subject matter as the Rust patent.

The Rust patent does not claim the same subject matter as recited in Applicants pending claims. Section 2306.01 of the MPEP specifically recites, "the fact that the patent may disclose subject matter claimed by the applicant is not a basis for interference if the patent does not claim that subject matter." (Emphasis added). Applicants do not admit that the Rust patent discloses subject matter claimed, and instead, Applicants submit that the Rust patent teaches away from the subject matter claimed. Further, Applicants respectfully submit that the Rust patent does not claim the same invention as claimed through the pending claims 1-24. For example, claim 1 of the Rust patent recites:

A computer implemented method comprising the steps of:
causing a first computer to control a browser application of a second computer, thereby enabling a collaborative web browsing session with a user of said second computer;
at said first computer, sending audio and visual data elements of said session

¹ The 131 Declaration, paragraph 4

² 37 CFR § 1.131(a) and MPEP 715

Page 10 of 13
Application No. 09/488,337
Amendment E

to a control server;
at said control server, storing said audio and visual data elements in a presentation file; and
after said storing step begins, at a selected computer, selecting said presentation file on said control server and playing back said audio and visual data elements sent from said control server.

(Emphasis added). The other independent claims 4, 9, 13 and 19 of Rust include similar language, where a first computer controls a web browser of a second computer.

Applicants respectfully submit that the pending claims 1-24 do not recite the same patentable invention as claimed in the Rust patent. For example, independent claim 1 recites in part, "providing an event stored in memory on at least one of the client apparatuses." (Emphasis added). The Rust patent does not claim, and further fails to teach or suggest that the "event" is stored on at least one of the client apparatuses. Instead, the Rust patent only claims that a first computer controls the web browsing session of a second computer. Therefore, claim 1 does not claim the same invention as recited in the claims of the Rust patent.

Further, pending claim 1 recites "storing information on the host computer for allowing a simultaneous playback of the same event from the memory on each of the client apparatuses...." (Emphasis added). The Rust patent does not claim the storing of information for simultaneous playback of the same event from the memory on each of the client apparatuses. Instead, the Rust patent only claims a first computer controlling "a browser application of a second computer." (Rust, claim 1). The Rust patent does not claim the storing information for allowing simultaneous playback of the same event from the memory on each of the client apparatuses, and instead teaches away from such an application as this would defeat the intended purpose of Rust in providing real time collaborative web browsing. Therefore, the Rust patent does not claim the same invention as recited in Applicants' pending claims.

Additionally, claim 1 recites "allowing the content and timing information to be downloaded utilizing the network for playback of said locally stored event and said downloaded content and timing information after the simultaneous playback." The Rust patent does not claim downloading both the content and the timing information, but instead, generates a log file that is

408941_1

Page 11 of 13
Application No. 09/488,337
Amendment E

never downloaded because all of the content from the collaborative web browsing session is already stored in an archive file that is sent to a requesting computer. Thus, the Rust patent teaches away from sending both the content and timing information because the content is already merged prior to sending for playback.

Pending independent claims 7, 13 and 19 include similar limitations as recited above. Therefore, the independent claims do not claim the same patentable invention as claimed in the Rust patent, and thus, a Declaration submitted under 37 C.F.R. 1.131 can be submitted to overcome the 35 U.S.C. 103(a) rejection.

Further, section 715.05 of the MPEP states, "[i]f the reference is a U.S. patent which claims the same invention as the application and its issue date is more than 1 year prior to the presentation of the claims to that invention in the application, a rejection of the claims of the application under 35 U.S.C. 135(b)(1) should be made." If the Examiner continues to believe that the subject application is claiming the same subject matter, then at least claims 19-24 should potentially instead have been rejected under 35 U.S.C. 135(b) and not 103(a), as claims 19-24 were added by amendment on June 4, 2004, more than a year from the March 18, 2003 issue date of the Rust patent. Therefore, Applicants respectfully request, if the Examiner continues to believe the claims recite the same subject matter as that claimed in the Rust patent and was not presented prior to the one year anniversary of the issuance of the Rust, that a new non-final rejection be issued.

Declaration Under 37 C.F.R. §1.131

3. Applicants submit herewith the 131 declaration for execution by all of the named inventors demonstrating that Applicants conceived and reduced to practice the invention as claimed prior to the effective date of the Rust patent. A fully executed declaration will be submitted in due course, and probably received by the Examiner prior to reviewing this response.

The 131 declaration under 37 C.F.R. 1.131 must establish possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a

408941_1

Page 12 of 13
Application No. 09/488,337
Amendment E

whole reads on it.³ Proof of a reduction to practice of the invention prior to the filing date of the reference is sufficient to overcome a rejection based upon the reference.⁴ Generally, proof of an actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.⁵

As established in the 131 declaration, an online synchronization system was used prior to November 18, 1999 and the contents were made available on a web-site for playback at a later date prior to November 18, 1999.⁶ Thus, the online event and storing of content for subsequent playback as described in Exhibits A and B describe a device falling within claims 1, 7, 13 and 19, i.e., claims 1, 7, 13 and 19 read upon such described device.

Therefore, given the 131 declaration and Exhibits A and B, it is respectfully submitted that a device covered under claims 1, 7, 13 and 19 existed prior to November 18, 1999 and that it would *work for its intended purpose*.⁷

Thus, as required under MPEP 715.07, it is submitted that an online synchronization system that includes all of the limitations specified in claims 1, 7, 13 and 19 *existed prior to November 18, 1999* and that the inventor recognized that the laser device *worked for its intended purpose prior to November 18, 1999*.

Thus, Applicants respectfully submit that a rejection of claims 1-24 under 35 U.S.C. § 103(a) is overcome and are in condition for allowance.

³ *In re Tanczyn*, 347 F.2d 830, 146 USPQ 298 (CCPA 1965) and MPEP 715.02

⁴ 37 CFR 1.131(b) and MPEP 715.07

⁵ MPEP 715.07

⁶ The 131 Declaration Paragraphs 5 and 6, Exhibit A and Exhibit B

⁷ The 131 Declaration Paragraph 8

Page 13 of 13
Application No. 09/488,337
Amendment E

CONCLUSION

Applicants submit that the above amendments and remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: March 21, 2005



Steven M. Freeland
Reg. No. 42,555
Attorney for Applicants
(858) 552-1311

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
Thomas F. Lebens
120 So. LaSalle Street, Ste. 1600
Chicago, IL 60603

408941_1